

REMARKS

Claims 3 and 4 have been amended to use proper claim language. The expression “D₃ derivative” was changed to “D₃ compound” as there is no antecedent basis for derivative. The amendment is not meant to limit the scope of the invention.

Office Action Summary

Disposition of Claims

Claims 3 and 4 are pending in the application. Claims 3 and 4 are rejected.

Information Disclosure Statement

The examiner has initialed and returned a copy of the PTO Form 1449 filed on July 15, 2003, with the Response under 37 C.F.R. § 1.116. The examiner has never returned an initialed copy of the PTO Form 1449 filed June 30, 1999. Accordingly, a copy of that PTO Form 1449 is submitted herewith, and the examiner is requested to return an initialed copy of the form with the next communication.

Double Patenting

Claim 3 was provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 7 and 8 of copending Application No. 10/069,481 and claims 1-3, 5-8 and 11-15 of copending Application No. 09/959,541.

Until cited by the examiner, applicants were not aware of the copending application and, furthermore, do not have access to the claims.

Nonetheless, Applicants note that the present application claims benefit to May 2, 1997, whereas the cited applications claim benefit to April 28, 1999 and August 27, 1999 (information taken from corresponding international applications). Accordingly, obviousness-type double

Amendment Under 37 C.F.R. § 1.111
U.S. Serial No. 09/214,155

patenting rejection should be issued in the cited applications, which were the later filed applications.

Therefore, the examiner is respectfully requested to remove the obviousness-type double patenting rejection and maintain it in the cited applications.

Furthermore, Applicants respectfully submit that the copending applications cited by the examiner are invalid and unpatentable over applicants' corresponding International Publication No. WO 98/50353 published November 12, 1998. WO 98/50353 is believed to have been published more than one year prior to the actual U.S. filing date of either of U.S. Application No. 10/069,481 or U.S. Application No. 09/959,541, and therefore is legally effective art under 35 U.S.C. § 102 (b) and/or 103 (a). Accordingly, it is believed that neither of the cited applications will issue.

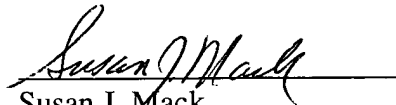
Therefore, at a minimum, the examiner is respectfully requested to hold this provisional obviousness-type double patenting rejection in abeyance until a decision on non-patentability is made in the cited applications.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Amendment Under 37 C.F.R. § 1.111
U.S. Serial No. 09/214,155

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


Susan J. Mack
Registration No. 30,951

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: December 22, 2003